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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/558,192
Filing Date: April 26, 2000
Appellant(s): NARASIMHASWAMY ET AL.

Benjamin C. Stasa, Registration No. 55,644
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on July 24, 2009 appealing from the Office action mailed on March 12, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,315,504	LEMBLE	5-1994
5,031,214	DZIEWIT ET AL	7-1991
6,434,580	TAKANO	8-2002

- AAPA (Applicant's Admitted Prior Art)

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

9.1 Claims 1-33 and 37-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 12, 16, 20, 27, and 33 recite *"**requesting**, from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure, **a next available docket information number for the permanently locked disclosure**"*. However, the original specification as filed does not provide enough support for the claims as amended. After careful review and search, Examiner only found page 11 lines 5-12 with figure 2 disclosing *"the accept disclosure transmission block 56 locks the document so no further changes can be made and obtains a docket ID number from a docketing system 58. The disclosure system makes the request and the docket system provides the next available docket number"*. The request mentioned here is a request for docket ID as explicitly illustrated in fig. 2 "requesting docket ID", not a request of a next available docket information number for the permanently locked disclosure as claimed. Therefore, the claim(s) contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

9.2 **Claims 1-11 and 20-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,315,504 to **Lemble** in view of US Patent 5,031,214 to **Dziewit et al** *(Applicant's IDS),* in view of AAPA (Applicant's Admitted Prior Art), and in view of US Patent 6,434,580 to **Takano**.

As per claim 1, **Lemble** substantially discloses an invention disclosure system comprising: *forming* electronic document approval online *by entering a plurality of selected information including a first inventor* (user/approver) *identification information from a user computer* (see column 6, lines 35-36; column 10, lines 43-52; and abstract; and figures 15-16); *as the plurality of selected information is entered into the user computer, storing the selected information in a central storage location* (see column 5, lines 44-48 and figs. 2-3 with description); *prompting approval of said first inventor* (user/approver) (see column 5, lines 21-25; column 9, lines 53-56; column 6, lines 9-15; and figures 4 and 6); and **Lemble** discloses in column 5, lines 33-40 and column 6, lines 9-22, locking the disclosure after approval, by sending the document to a finalizing VM machine to perform a final update, format, and even encryption of the document and sending the document to another network node, performing a control operation to ascertain a higher security level. **Lemble** is silent as to this final process is a permanent locking to prevent further editing of the disclosure. However, **Dziewit et al** in an analogous art discloses (see column 2) producing a final authenticated document using

computerized techniques which documents satisfies the legal document authentication and authenticity requirements (column 2, lines 5-15). **Dziewit et al** further discloses the document authentication process includes locking the document to prevent any further changes to thereby avoid tampering (see column 11, lines 13-27); appending a digital signature to the final signed document (after approval) to prevent the document from being altered, the authenticated document with the digital signature appended thereto can then be electronically archived on electronic media as a permanent document (see column 2, lines 47-61 and column 8, lines 52-65), which meets the recitation of *after approval permanently locking the disclosure to prevent further editing of the disclosure*. One of the advantages as disclosed by **Dziewit et al** is that the stored document can provide a permanent record to which a court can turn in the event of a dispute (see column 4, lines 18-20 and column 2, lines 41-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention disclosed by **Lemble** to implement a permanent locking process to prevent any further changes as to thereby avoid tampering and also one of ordinary skill in the art would have been motivated to do so because it could provide a permanent record that may be used in a legal process as suggested by **Dziewit et al** (see column 2, lines 47-61 and column 8, lines 52-65, and column 11, lines 13-27).

Lemble's invention is directed to fill in forms electronically as the form is made available to many selected users for approval and modification based on predefined approval rules and requestor identity. **Lemble** discloses the invention with respect to users and approvers in a company setting for preparing an electronic disclosure or form, but does not specifically refer to the form as an invention disclosure which inherently is prepared by users that include

inventors and patent law persons. It would have required merely routine skill in the art to replace the users and approvers of **Lemble** by first/second inventor as it is well known that more than one inventor may be involved in a filing of an invention disclosure. **Takano** in an analogous art teaches preparing an online patent disclosure by inventor users with other patent application-filing persons including a patent attorney (see column 1, lines 1-19 and column 2, lines 1-10). **Takano** further discloses automatically assigning to an invention report a reference number in accordance with a prescribed rule (e.g. a serial number assigned in the temporal order of the reporting of inventions) which will help in identifying the document (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6). In another embodiment, **Takano** discloses upon completion of final revision of the draft data by the patent-application filing persons, the patent application document data transmitting means 205 of the client computer 200 transmits the draft data for the specification for patent application accompanied with the document data on the application to the client computer 500 to be used by the patent office, and the client computer 500 to be used by the patent office provides the reference number including application number and application date (see column 15, lines 45-47 and column 16, lines 26-65). **Takano** is silent about *requesting from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure.* However, these features are either implicit, inherent, or obvious in the system disclosed by Takano between the client computer and the docketing system of the patent office. Applicant's Admitted Prior Art discloses on page 2:

"Corporate patent departments also typically maintain a docketing system. The docketing system keeps track of the disclosures as they are processed by the patent department. The docketing system 25 maintains the status of disclosures for the patent attorneys and patent coordinators and of any patent applications originating therefrom. Various due dates of the docket system are also tracked."

shows that the docketing system features as claimed are well-known in the art so is a request for a docket ID number as disclosed in US Patent 6,430,581 to Mahoney et al, column 7, lines 1-20.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of **Lemble** into an invention disclosure environment, by combining the electronic filing document approval system of **Lemble** with the features of filing an invention disclosure by inventors and patent attorneys as taught by **Takano** for the purpose of conveniently preparing a patent application via a transmission and reception of application data between the inventor and other patent application-filing users as suggested by Takano (see column 1, line 63 through column 2, line 10), and requesting a docket number and obtaining and assigning a next available docket number to the document from a docketing system that maintains status and track due dates would provide a convenient way to identify the document as suggested by **Takano** (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6 and column 16, lines 26-65).

As per claim 2, the combination of **Lemble, Dziewit et al,** and **Takano** discloses the limitation of further comprising the step of generating an approval log (see **Lemble**, column 10, lines 44-52).

As per claim 3, the combination of **Lemble, Dziewit et al,** and **Takano** discloses the limitation of wherein the step of generating an approval log comprises recording the date of an approval (see **Lemble**, column 10, lines 44-52).

As per claim 4, the combination of **Lemble, Dziewit et al,** and **Takano** discloses the limitation of further comprising associating the approval log with the disclosure (see **Lemble**, column 18, line 60 through column 19, line 14). **Lemble** discloses each document has an approval log associated with the document that can be view as a user selects the document.

As per claim 5, the combination of **Lemble, Dziewit et al, and Takano** discloses the limitation of wherein forming is performed by a non-inventor author (see **Lemble**, column 5, lines 15-20 and column 14, lines 40-60).

As per claim 6, the combination of **Lemble, Dziewit et al,** and **Takano** discloses the limitation of wherein the step of forming comprises identifying a second inventor; and further comprising the steps of notifying the second inventor; and, prompting the second inventor to approve the invention disclosure (see **Lemble**, column 18, lines 1-22; abstract, and figure 4).

As per claim 7, the combination of **Lemble, Dziewit et al, and Takano** discloses the limitation of further comprising revising the disclosure by the second inventor to form a revised disclosure, and prompting the first inventor to approve the revised disclosure (see **Lemble,** column 20, line 40 through column 21, line 54).

As per claim 8, the combination of **Lemble, Dziewit et al,** and **Takano** discloses the limitation of wherein prompting the second inventor comprises providing an E-mail to the second inventor (see **Lemble**, column 18, lines 1-22).

As per claim 9, the combination of **Lemble, Dziewit et al,** and **Takano** discloses the limitation of wherein prompting comprises the step of prompting the approval of an associated document (see **Lemble**, **c**olumn 5, lines 21-25; column 9, lines 53-56; figures 4 and 6; and abstract).

As per claim 10, the combination of **Lemble, Dziewit et al,** and **Takano** discloses wherein the associated document is selected from a group consisting of an assignment document, and a power of attorney. **Takano** teaches preparing an online patent application which implicitly or inherently includes assignment document and power of attorney (see **Takano**, column 19, lines 14-53). Therefore, claim 10 is rejected on the same rationale as the rejection of claim 1 above.

As per claim 11, the combination of **Lemble, Dziewit et al,** and **Takano** discloses the limitation of further comprising allowing access to various users for obtaining the information (see **Lemble**, column 5, lines 15-32 and abstract).

As per claim 20, **Lemble** substantially discloses an invention disclosure system comprising: *forming* electronic document approval online *by entering a plurality of selected*

information including a first inventor (user/approver) *identification information and a second inventor* (approver) *identification information from a user computer* (see column 6, lines 9-15; lines 35-36; column 10, lines 43-52; column 19, lines 50-55; column 20, lines 40-65; and abstract; and figures 15-16); *as the plurality of selected information is entered into the user computer, storing the selected information in a central storage location* (see column 5, lines 44-48; and figs. 2-3 with description); *prompting approval of said first inventor* (see column 5, lines 21-25; column 9, lines 53-56; column 6, lines 9-15; and figures 4 and 6); *notifying the second inventor* (approver) *and, prompting the second inventor to approve the invention disclosure* (see **Lemble**, column 18, lines 1-22; abstract, and figure 4). **Lemble** discloses in column 5, lines 33-40 and column 6, lines 9-22, locking the disclosure to create a locked disclosure when the second inventor approves the disclosure (as shown in fig. 4 first or second approver (second inventor) can be the last approver), by sending the document to a finalizing VM machine to perform a final update, format, and even encryption of the document and sending the document to another network node, performing a control operation to ascertain a higher security level. **Lemble** is silent as to this final process is a permanent locking to prevent further editing of the disclosure. However, **Dziewit et al** in an analogous art discloses (see column 2) producing a final authenticated document using computerized techniques which documents satisfies the legal document authentication and authenticity requirements (column 2, lines 5-15). **Dziewit et al** further discloses the document authentication process includes locking the document to prevent any further changes to thereby avoid tampering (see column 11, lines 13-27); appending a digital signature to the final signed document (after approval by the parties) to prevent the document from being altered, the authenticated document with the digital signature appended thereto can

then be electronically archived on electronic media as a permanent document (see column 2, lines 47-61 and column 8, lines 52-65), which meets the recitation of *permanently locking the disclosure to create a locked disclosure to prevent further editing of the disclosure when the second inventor approves the disclosure*. One of the advantages as disclosed by **Dziewit et al** is that the stored document can provide a permanent record to which a court can turn in the event of a dispute (see column 4, lines 18-20 and column 2, lines 41-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention disclosed by **Lemble** to implement a permanent locking process to prevent any further changes as to thereby avoid tampering and also one of ordinary skill in the art would have been motivated to do so because it could provide a permanent record that may be used in a legal process as suggested by **Dziewit et al** (see column 2, lines 47-61 and column 8, lines 52-65, and column 11, lines 13-27).

Lemble's invention is directed to fill in forms electronically as the form is made available to many selected users for approval and modification based on predefined approval rules and requestor identity. **Lemble** discloses the invention with respect to users and approvers in a company setting for preparing an electronic disclosure or form, but does not specifically refer to the form as an invention disclosure which inherently is prepared by users that include inventors and patent law persons. It would have required merely routine skill in the art to replace the users and approvers of **Lemble** by first/second inventor as it is well known that more than one inventor may be involved in a filing of an invention disclosure. **Takano** in an analogous art teaches preparing an online patent disclosure by inventor users with other patent application-filing persons including a patent attorney (see column 1, lines 1-19 and column 2, lines 1-10).

Takano further discloses automatically assigning to an invention report a reference number in accordance with a prescribed rule (e.g. a serial number assigned in the temporal order of the reporting of inventions) which will help in identifying the document (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6). In another embodiment, **Takano** discloses upon completion of final revision of the draft data by the patent-application filing persons, the patent application document data transmitting means 205 of the client computer 200 transmits the draft data for the specification for patent application accompanied with the document data on the application to the client computer 500 to be used by the patent office, and the client computer 500 to be used by the patent office provides the reference number including application number and application date (see column 15, lines 45-47 and column 16, lines 26-65). **Takano** is silent about *requesting from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure.* However, these features are either implicit, inherent, or obvious in the system disclosed by Takano between the client computer and the docketing system of the patent office. Applicant's Admitted Prior Art (AAPA) discloses on page 2:

"Corporate patent departments also typically maintain a docketing system. The docketing system keeps track of the disclosures as they are processed by the patent department. The docketing system 25 maintains the status of disclosures for the patent attorneys and patent coordinators and of any patent applications originating therefrom. Various due dates of the docket system are also tracked."

shows that the docketing system features as claimed are well-known in the art so is a request for a docket ID number as disclosed in US Patent 6,430,581 to Mahoney et al, column 7, lines 1-20.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of **Lemble** into an invention disclosure

environment, by combining the electronic filing document approval system of **Lemble** with the features of filing an invention disclosure by inventors and patent attorneys as taught by **Takano** for the purpose of conveniently preparing a patent application via a transmission and reception of application data between the inventor and other patent application-filing users as suggested by Takano (see column 1, line 63 through column 2, line 10), and requesting a docket number and obtaining and assigning a next available docket number to the document from a docketing system that maintains status and track due dates would provide a convenient way to identify the document as suggested by **Takano** (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6 and column 16, lines 26-65).

As per claim 21, the combination of **Lemble, Dziewit et al,** and **Takano** discloses the limitation of further comprising the step of generating an approval log (see **Lemble**, column 10, lines 44-52).

As per claim 22, the combination of **Lemble, Dziewit et al,** and **Takano** discloses the limitation of wherein the step of generating an approval log comprises recording the date of an approval (see **Lemble**, column 10, lines 44-52).

As per claim 23, the combination of **Lemble, Dziewit et al,** and **Takano** discloses the limitation of further comprising associating the approval log with the disclosure (see **Lemble**, column 18, line 60 through column 19, line 14). **Lemble** discloses each document has an approval log associated with the document that can be view as a user selects the document.

As per claim 24, the combination of **Lemble, Dziewit et al,** and **Takano** discloses the limitation of further comprising locking the disclosure when the second inventor approves the disclosure (see **Lemble**, column 5, lines 33-40). (As shown in fig. 4 first or second approver (second inventor) can be the last approver).

As per claim 25, the combination of **Lemble, Dziewit et al,** and **Takano** discloses the limitation of further comprising locking the disclosure when the first inventor approves the revised disclosure (see **Lemble**, column 20; column 6, lines 9-23; and column 5, lines 33-40). **Lemble** discloses a revised disclosure can be sent to a first user or first approver for approval if the user or first approver is the last approver locking the disclosure may take place.

As per claim 26, the combination of **Lemble, Dziewit et al,** and **Takano** discloses the limitation of wherein providing an E-mail to the second inventor comprises providing an E-mail to the second inventor having a hyperlink to the disclosure therein (see **Lemble**, column 18, lines 1-22 and abstract).

As per claim 27, **Lemble** substantially discloses an invention disclosure system comprising: *forming* electronic document approval online *by entering a plurality of information including one or more inventor identifications from one or more inventors to form an invention disclosure from a user computer* (see column 6, lines 35-36; column 10, lines 43-52; and abstract; and figures 15-16); *storing the information in a central storage location* (see column 5,

lines 44-48 and figs. 2-3 with description); *prompting approval of the one or more inventors* (user/approver) (see column 5, lines 21-25; column 9, lines 53-56; column 6, lines 9-15; and figures 4 and 6). **Lemble** discloses in column 5, lines 33-40 and column 6, lines 9-22, locking the disclosure to create a locked disclosure after each of the one or more inventors approve the disclosure, by sending the document to a finalizing VM machine to perform a final update, format, and even encryption of the document and sending the document to another network node, performing a control operation to ascertain a higher security level. **Lemble** is silent as to this final process is a permanent locking to prevent further editing of the disclosure. However, **Dziewit et al** in an analogous art discloses (see column 2) producing a final authenticated document using computerized techniques which documents satisfies the legal document authentication and authenticity requirements (column 2, lines 5-15). **Dziewit et al** further discloses the document authentication process includes locking the document to prevent any further changes to thereby avoid tampering (see column 11, lines 13-27); appending a digital signature to the final signed document (after approval) to prevent the document from being altered, the authenticated document with the digital signature appended thereto can then be electronically archived on electronic media as a permanent document (see column 2, lines 47-61 and column 8, lines 52-65), which meets the recitation of *permanently locking the disclosure to create a locked disclosure to prevent further editing of the disclosure after each of the one or more inventors approve the disclosure*. One of the advantages as disclosed by **Dziewit et al** is that the stored document can provide a permanent record to which a court can turn in the event of a dispute (see column 4, lines 18-20 and column 2, lines 41-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the

invention disclosed by **Lemble** to implement a permanent locking process to prevent any further changes as to thereby avoid tampering and also one of ordinary skill in the art would have been motivated to do so because it could provide a permanent record that may be used in a legal process as suggested by **Dziewit et al** (see column 2, lines 47-61 and column 8, lines 52-65, and column 11, lines 13-27).

Lemble's invention is directed to fill in forms electronically as the form is made available to many selected users for approval and modification based on predefined approval rules and requestor identity. **Lemble** discloses the invention with respect to users and approvers in a company setting for preparing an electronic disclosure or form, but does not specifically refer to the form as an invention disclosure which inherently is prepared by users that include inventors and patent law persons. It would have required merely routine skill in the art to replace the users and approvers of **Lemble** by first/second inventor as it is well known that more than one inventor may be involved in a filing of an invention disclosure. **Takano** in an analogous art teaches preparing an online patent disclosure by inventor users with other patent application-filing persons including a patent attorney (see column 1, lines 1-19 and column 2, lines 1-10). **Takano** further discloses automatically assigning to an invention report a reference number in accordance with a prescribed rule (e.g. a serial number assigned in the temporal order of the reporting of inventions) which will help in identifying the document (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6). In another embodiment, **Takano** discloses upon completion of final revision of the draft data by the patent-application filing persons, the patent application document data transmitting means 205 of the client computer 200 transmits the draft data for the specification for patent application accompanied with the document data on

the application to the client computer 500 to be used by the patent office, and the client computer 500 to be used by the patent office provides the reference number including application number and application date (see column 15, lines 45-47 and column 16, lines 26-65). **Takano** is silent about *requesting from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure.* However, these features are either implicit, inherent, or obvious in the system disclosed by Takano between the client computer and the docketing system of the patent office. Applicant's Admitted Prior Art discloses on page 2:

"Corporate patent departments also typically maintain a docketing system. The docketing system keeps track of the disclosures as they are processed by the patent department. The docketing system 25 maintains the status of disclosures for the patent attorneys and patent coordinators and of any patent applications originating therefrom. Various due dates of the docket system are also tracked."

shows that the docketing system features as claimed are well-known in the art so is a request for a docket ID number as disclosed in US Patent 6,430,581 to Mahoney et al, column 7, lines 1-20.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of **Lemble** into an invention disclosure environment, by combining the electronic filing document approval system of **Lemble** with the features of filing an invention disclosure by inventors and patent attorneys as taught by **Takano** for the purpose of conveniently preparing a patent application via a transmission and reception of application data between the inventor and other patent application-filing users as suggested by Takano (see column 1, line 63 through column 2, line 10), and requesting a docket number and obtaining and assigning a next available docket number to the document from a docketing system that maintains status and track due dates would provide a convenient way to identify the

document as suggested by **Takano** (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6 and column 16, lines 26-65).

As per claim 28, the combination of **Lemble, Dziewit et al,** and **Takano** discloses the limitation of further comprising the step of generating an approval log (see **Lemble**, column 10, lines 44-52).

As per claim 29, the combination of **Lemble, Dziewit et al,** and **Takano** discloses the limitation of wherein the step of generating an approval log comprises recording the date of an approval from each of the one or more inventors (see **Lemble**, column 10, lines 44-52).

As per claim 30, the combination of **Lemble, Dziewit et al,** and **Takano** discloses the limitation of further comprising associating the approval log with the disclosure (see **Lemble**, column 18, line 60 through column 19, line 14). **Lemble** discloses each document has an approval log associated with the document that can be view as a user selects the document.

As per claim 31, the combination of **Lemble, Dziewit et al,** and **Takano** discloses the limitation of wherein prompting comprises prompting the one or more inventor comprises providing an E-mail to the one or more inventors having a hyperlink to the disclosure therein (see **Lemble**, column 18, lines 1-22 and abstract).

As per claim 32, the combination of **Lemble, Dziewit et al,** and **Takano** discloses the limitation of wherein providing an E-mail to the one or more inventors comprises providing an E-mail to the one or more inventors having a hyperlink to the disclosure therein (see **Lemble**, column 18, lines 1-22 and abstract).

9.3 **Claims 16-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,315,504 to **Lemble** in view of US Patent 5,031,214 to **Dziewit et al** *(Applicant's IDS)* in view of AAPA (Applicant's Admitted Prior Art), and in view of US Patent 6,434,580 to **Takano**.

As per claim 16, **Lemble** discloses an invention disclosure system comprising *a user computer, a server,* (see figure 1 and tables in column 7 and column 9); *a database coupled to the server* (see figure 1 and figure 3 and column 4, line 39). **Lemble** further discloses *said server providing user screens to said users to prompt users to provide disclosure information to said server*, (see figure 2 and claims 5-6); *receiving disclosure information from said users, including a first inventor identification and a second inventor identification* (see column 6, lines 9-15; column 19, lines 50-55; column 20, lines 40-65; and abstract); storing information in said database (see column 3, lines 40-62 and column 4, lines 25-47; column 29, lines 8-15; and figure 4); *prompting the first inventor and the second inventor to provide an approval* (see column 5, lines 20-40). **Lemble** discloses in column 5, lines 33-40 and column 6, lines 9-22, locking the disclosure after the approval by the first inventor and the second inventor (as shown in fig. 4 first or second approver (second inventor) can be the last approver), by sending the document to a finalizing VM machine to perform a final update, format, and even encryption of the document

and sending the document to another network node, performing a control operation to ascertain a higher security level. **Lemble** is silent as to this final process is a permanent locking of the document. However, **Dziewit et al** in an analogous art discloses (see column 2) producing a final authenticated document using computerized techniques which documents satisfies the legal document authentication and authenticity requirements (column 2, lines 5-15). **Dziewit et al** further discloses the document authentication process includes locking the document to prevent any further changes to thereby avoid tampering (see column 11, lines 13-27); appending a digital signature to the final signed document (after approval by the parties) to prevent the document from being altered, the authenticated document with the digital signature appended thereto can then be electronically archived on electronic media as a permanent document (see column 2, lines 47-61 and column 8, lines 52-65), which meets the recitation of *locking the disclosure to prevent further editing after the approval by the first inventor and the second inventor*. One of the advantages as disclosed by **Dziewit et al** is that the stored document can provide a permanent record to which a court can turn in the event of a dispute (see column 4, lines 18-20 and column 2, lines 41-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention disclosed by **Lemble** to implement a permanent locking process to prevent any further changes as to thereby avoid tampering and also one of ordinary skill in the art would have been motivated to do so because it could provide a permanent record that may be used in a legal process as suggested by **Dziewit et al** (see column 2, lines 47-61 and column 8, lines 52-65, and column 11, lines 13-27). **Lemble** is silent as to obtaining and assigning a next available docket number to the document. **Takano** in an analogous art teaches preparing an online patent disclosure by inventor users with other patent

application-filing persons including a patent attorney (see column 1, lines 1-19 and column 2, lines 1-10). **Takano** further discloses automatically assigning to an invention report a reference number in accordance with a prescribed rule (e.g. a serial number assigned in the temporal order of the reporting of inventions) which will help in identifying the document (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6). In another embodiment, **Takano** discloses upon completion of final revision of the draft data by the patent-application filing persons, the patent application document data transmitting means 205 of the client computer 200 transmits the draft data for the specification for patent application accompanied with the document data on the application to the client computer 500 to be used by the patent office, and the client computer 500 to be used by the patent office provides the reference number including application number and application date (see column 15, lines 45-47 and column 16, lines 26-65). **Takano** is silent about *requesting from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure.* However, these features are either implicit, inherent, or obvious in the system disclosed by Takano between the client computer and the docketing system of the patent office. Applicant's Admitted Prior Art discloses on page 2:

"Corporate patent departments also typically maintain a docketing system. The docketing system keeps track of the disclosures as they are processed by the patent department. The docketing system 25 maintains the status of disclosures for the patent attorneys and patent coordinators and of any patent applications originating therefrom. Various due dates of the docket system are also tracked."

shows that the docketing system features as claimed are well-known in the art so is a request for a docket ID number as disclosed in US Patent 6,430,581 to Mahoney et al, column 7, lines 1-20.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of **Lemble** into an invention disclosure environment, by combining the electronic filing document approval system of **Lemble** with the features of filing an invention disclosure by inventors and patent attorneys as taught by **Takano** for the purpose of conveniently preparing a patent application via a transmission and reception of application data between the inventor and other patent application-filing users as suggested by Takano (see column 1, line 63 through column 2, line 10), and requesting a docket number and obtaining and assigning a next available docket number to the document from a docketing system that maintains status and track due dates would provide a convenient way to identify the document as suggested by **Takano** (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6 and column 16, lines 26-65).

As per claim 17, **Lemble** discloses the claimed system of claim 16, wherein said server generated an approval log associated with said disclosure (see column 10, lines 44-52).

As per claim 18, **Lemble** discloses wherein said server associates said approval log with said disclosure (see column 10, lines 4-52 and column 18, line 60 through column 19, line 14).

As per claim 19, **Lemble** discloses the claimed system of claim 16, further comprising a directory system coupled to said server whereby upon providing identification information to server said server retrieves user information from the directory system in response to the identification information (see column 25, lines 10-33 and figures 3-4).

9.4 **Claims 12-15, 33, 37-39, and 41** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,315,504 to **Lemble** in view of AAPA (Applicant's Admitted Prior Art), in view of US Patent 6,434,580 to **Takano**.

As per claim 12, **Lemble** discloses an invention disclosure system comprising: *a user computer, a web server having an identification subsystem*, (see figure 1 and tables in column 7 and column 9); *a database coupled to the server* (see figure 1 and figure 3 and column 4, line 39). **Lemble** further discloses *said server providing user screens to said users so users provide disclosure information to said server*, (see figure 2 and claims 5-6); *receiving disclosure information from said users, storing information in said database* (see column 3, lines 40-62 and column 4, lines 25-47; and claim 1) and (see also column 29, lines 8-15; and figure 4); **Lemble** discloses a screen is provided to a user to enter disclosure information which is stored in the SEALDBA (sealing database) and is prompted to provide a password associated with a disclosure and access to the disclosure is allowed after storing information in the database upon entering the password associated with the disclosure that meets the recitation of *prompting a user to provide a password associated with the disclosure and allowing access to said disclosure after storing said information in said database upon entering the password associated with the disclosure* (see column 4, lines 3-21; column 26, lines 15-37 and column 26, line 64 through column 27, line 34). **Lemble** is silent as to obtaining and assigning a next available docket number to the document. **Takano** in an analogous art teaches preparing an online patent disclosure by inventor users with other patent application-filing persons including a patent

attorney (see column 1, lines 1-19 and column 2, lines 1-10). **Takano** further discloses automatically assigning to an invention report a reference number in accordance with a prescribed rule (e.g. a serial number assigned in the temporal order of the reporting of inventions) which will help in identifying the document (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6). In another embodiment, **Takano** discloses upon completion of final revision of the draft data by the patent-application filing persons, the patent application document data transmitting means 205 of the client computer 200 transmits the draft data for the specification for patent application accompanied with the document data on the application to the client computer 500 to be used by the patent office, and the client computer 500 to be used by the patent office provides the reference number including application number and application date (see column 15, lines 45-47 and column 16, lines 26-65). **Takano** is silent about *requesting from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure*. However, these features are either implicit, inherent, or obvious in the system disclosed by Takano between the client computer and the docketing system of the patent office. Applicant's Admitted Prior Art discloses on page 2:

"Corporate patent departments also typically maintain a docketing system. The docketing system keeps track of the disclosures as they are processed by the patent department. The docketing system 25 maintains the status of disclosures for the patent attorneys and patent coordinators and of any patent applications originating therefrom. Various due dates of the docket system are also tracked."

shows that the docketing system features as claimed are well-known in the art so is a request for a docket ID number as disclosed in US Patent 6,430,581 to Mahoney et al, column 7, lines 1-20.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of **Lemble** into an invention disclosure environment, by combining the electronic filing document approval system of **Lemble** with the features of filing an invention disclosure by inventors and patent attorneys as taught by **Takano** for the purpose of conveniently preparing a patent application via a transmission and reception of application data between the inventor and other patent application-filing users as suggested by Takano (see column 1, line 63 through column 2, line 10), and requesting a docket number and obtaining and assigning a next available docket number to the document from a docketing system that maintains status and track due dates would provide a convenient way to identify the document as suggested by **Takano** (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6 and column 16, lines 26-65).

As per claim 13, **Lemble** discloses the claimed system of claim 12, further comprising a directory system coupled to said server whereby upon providing identification information to server said server retrieves user information from the directory system in response to the identification information (see column 25, lines 10-33 and figures 3-4).

As per claim 14, **Lemble** discloses the claimed system of claim 12, wherein said server creates a user log (see column (see column 10, lines 44-52).

As per claim 15, **Lemble** discloses the claimed system of claim 12, wherein said server associates said approval log with said disclosure (see column 10, lines 4-52).

As per claim 33, **Lemble** discloses an invention disclosure system comprising: *forming a document online by entering a plurality of selected information including a first user* (user/approver column 14, lines 40-59) *identification information from a user computer* (see column 6, lines 35-36; column 10, lines 43-52; and abstract; and figures 11, 15-16); (as interpreted by Examiner, Lemble discloses in column 6, lines 9-15, column 19, line 50-column 20, line 11 that either the user or the approver can approve the document and the user can be an approver); *storing the selected information in a central storage location* (see column 5, lines 44-48 and figs. 2-3 with description); prompting approval of said first user (user/approver) (see column 9, lines 53-56; column 6, lines 9-15; and figures 4 and 6); and generating an approval log comprising a date of approval by all inventors and associating the approval log with the document (see column 10, lines 44-52 and column 13, lines 1-8). **Lemble** discloses each document has an approval log associated with the document that can be view as a user selects the document (see column 18, line 60 through column 19, line 14). **Lemble** is silent as to obtaining and assigning a next available docket number to the document. **Takano** in an analogous art teaches preparing an online patent disclosure by inventor users with other patent application-filing persons including a patent attorney (see column 1, lines 1-19 and column 2, lines 1-10). **Takano** further discloses automatically assigning to an invention report a reference number in accordance with a prescribed rule (e.g. a serial number assigned in the temporal order of the reporting of inventions) which will help in identifying the document (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6). In another embodiment, **Takano** discloses upon completion of final revision of the draft data by the patent-application filing persons, the

patent application document data transmitting means 205 of the client computer 200 transmits the draft data for the specification for patent application accompanied with the document data on the application to the client computer 500 to be used by the patent office, and the client computer 500 to be used by the patent office provides the reference number including application number and application date (see column 15, lines 45-47 and column 16, lines 26-65). **Takano** is silent about *requesting from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure.* However, these features are either implicit, inherent, or obvious in the system disclosed by Takano between the client computer and the docketing system of the patent office. Applicant's Admitted Prior Art discloses on page 2:

"Corporate patent departments also typically maintain a docketing system. The docketing system keeps track of the disclosures as they are processed by the patent department. The docketing system 25 maintains the status of disclosures for the patent attorneys and patent coordinators and of any patent applications originating therefrom. Various due dates of the docket system are also tracked."

shows that the docketing system features as claimed are well-known in the art so is a request for a docket ID number as disclosed in US Patent 6,430,581 to Mahoney et al, column 7, lines 1-20.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of **Lemble** into an invention disclosure environment, by combining the electronic filing document approval system of **Lemble** with the features of filing an invention disclosure by inventors and patent attorneys as taught by **Takano** for the purpose of conveniently preparing a patent application via a transmission and reception of application data between the inventor and other patent application-filing users as suggested by Takano (see column 1, line 63 through column 2, line 10), and requesting a docket number and

obtaining and assigning a next available docket number to the document from a docketing system that maintains status and track due dates would provide a convenient way to identify the document as suggested by **Takano** (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6 and column 16, lines 26-65).

As per claim 37, **Lemble** discloses further comprising the steps of notifying the second user; and, prompting the second user to approve the document (see column 18, lines 1-22; abstract, and figure 4).

As per claim 38, **Lemble** discloses revising the document by the second user to form a revised document, and prompting the first inventor to approve the revised document (see column 20, line 40 through column 21, line 54).

As per claim 39, **Lemble** discloses wherein prompting the second user comprises providing an E-mail to the second user (see column 18, lines 1-22).

As per claim 41, **Lemble** substantially discloses the claimed method of claim 33. **Takano** teaches preparing an online patent application which implicitly or inherently includes assignment document and power of attorney (see **Takano**, column 19, lines 14-53). Therefore, claim 41 is rejected on the same rationale as the rejection of claim 1 above.

9.5 **Claim 40** is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,315,504 to **Lemble** in view of AAPA (Applicant's Admitted Prior Art), in view of US Patent 6,434,580 to **Takano** as applied to claims 37-39 and 41 and further in view of US Patent 5,031,214 to **Dziewit et al** *(Applicant's IDS)*.

As per claim 40, **Lemble** discloses in column 5, lines 33-40 and column 6, lines 9-22, locking the disclosure when the second inventor approves the disclosure (as shown in fig. 4 first or second approver (second inventor) can be the last approver), by sending the document to a finalizing VM machine to perform a final update, format, and even encryption of the document and sending the document to another network node, performing a control operation to ascertain a higher security level. **Lemble** is silent as to this final process is a permanent locking of the document. However, **Dziewit et al** in an analogous art discloses (see column 2) producing a final authenticated document using computerized techniques which documents satisfies the legal document authentication and authenticity requirements (column 2, lines 5-15). **Dziewit et al** further discloses the document authentication process includes locking the document to prevent any further changes to thereby avoid tampering (see column 11, lines 13-27); appending a digital signature to the final signed document (after approval by the parties) to prevent the document from being altered, the authenticated document with the digital signature appended thereto can then be electronically archived on electronic media as a permanent document (see column 2, lines 47-61 and column 8, lines 52-65), which meets the recitation of *permanently locking the document when the second user approves the document*. One of the advantages as disclosed by **Dziewit et al** is that the stored document can provide a permanent record to which a court can

turn in the event of a dispute (see column 4, lines 18-20 and column 2, lines 41-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention as combined above to implement a permanent locking process to prevent any further changes as to thereby avoid tampering and also one of ordinary skill in the art would have been motivated to do so because it could provide a permanent record that may be used in a legal process as suggested by **Dziewit et al** (see column 2, lines 47-61 and column 8, lines 52-65, and column 11, lines 13-27).

(10) Response to Argument

10.1 With respect to the 35 USC 112 first paragraph rejection, Appellant argues that the claim need not be recited verbatim in the detailed description. However, Examiner asserts that the claim language *requesting a next available docket information number for the permanently locked disclosure* is not equivalent to the original specification which merely states making a request or requesting a docket ID number. The original specification as filed did not explicitly describe the request as a request of the next available docket information number for the permanently locked disclosure. Also, the disclosure system that makes the request has no knowledge of what the next available docket information number is in the docketing system as to requesting specifically the next available docket information number for the permanently locked disclosure.

10.2 **As per claim 1**, Appellant's arguments with respect to the prior art rejection of claim 1, see appeal brief pages 7-9, are not persuasive. Appellant argues that Lemble already provides a

way to identify its documents and for this reason Examiner's proposed combination would appear to unnecessarily add redundancy, and there is no articulated reasoning to support the legal conclusion of obviousness. Examiner respectfully disagrees as the advantages are within the knowledge of one of ordinary skill in the art. Note that Appellant did not take into consideration the whole rejection, and some of the missing part is reproduced below:

Takano in an analogous art teaches preparing an online patent disclosure by inventor users with other patent application-filing persons including a patent attorney (see column 1, lines 1-19 and column 2, lines 1-10). **Takano** further discloses automatically **assigning to an invention report a reference number** in accordance with a prescribed rule (e.g. a serial number assigned in the temporal order of the reporting of inventions) which will help in identifying the document (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6). In another embodiment, **Takano** discloses **upon completion of final revision of the draft data** by the patent-application filing persons, the patent application document data transmitting means 205 of the client computer 200 transmits the draft data for the specification for patent application accompanied with the document data on the application to the client computer 500 to be used by the patent office, **and the client computer 500 to be used by the patent office provides the reference number including application number and application date** (see column 15, lines 45-47 and column 16, lines 26-65).

As shown above, Takano also has a way to identify his document with a reference number similar to Lemble, but still receives an application number (docket identification number) from the patent office. Therefore, modifying Lemble to receive an application number (docket identification number) from the patent office as in Takano is not redundant.

In response to appellant's arguments that there is no reason to combine, one of ordinary skill in the art would have recognized some of the advantages of a docketing system, which is a well-known method. For instance, the docket identification number in Takano enables to

distinguish an application being filed at the patent office from an application that is still in process at the company or at the attorney's office. The additional functionality is that the application number or docket identification number allows to identify the application being filed at the patent office whereas the reference number by itself does not indicate whether the application is being finalized or filed at the patent office. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of **Lemble** into an invention disclosure environment, by combining the electronic filing document approval system of **Lemble** with the features of filing an invention disclosure by inventors and patent attorneys as taught by **Takano** to requesting a docket number and obtaining and assigning a next available docket number to the document from a docketing system that maintains status and track due dates because it would enable to distinguish an application being filed at the patent office from an application that is still in process at the company or at the attorney's office.

These benefits are within the knowledge of one of ordinary skill in the art. *"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."* KSR Int'l Co. v. Teleflex, Inc., 550 U.S. 398, 416 (2007). Note also that the rejection shows that a docket system is well-known in the art as admitted by Applicant and as shown in Mahoney provided by Examiner as additional proof.

Appellant also argues on page 9 that Takano's reference number appears to be assigned while the disclosure is initially being entered and is not assigned after approval and locked.

Examiner clearly indicated in the rejection (see below) that Takano discloses the application number or docket identification number is assigned after approval of the application.

In another embodiment, **Takano** discloses **upon completion of final revision of the draft data** by the patent-application filing persons, the patent application document data transmitting means 205 of the client computer 200 transmits the draft data for the specification for patent application accompanied with the document data on the application to the client computer 500 to be used by the patent office, **and the client computer 500 to be used by the patent office provides the reference number including application number and application date** (see column 15, lines 45-47 and column 16, lines 26-65).

In addition, Mahoney, as shown in the rejection, discloses well-known art in column 7, lines 1-20 of requesting and obtaining a next available docket number after locking the document:

"If decision block 128 determines that the filer agrees with the money credited information or with the terms of future payment the program goes to block 200. Block 200 shows instructions on the screen of the display of interface 53. An example of the aforementioned instructions are **"place the document** you wish to file face up **in the drawer of module** 59". Then the program goes to block 210 to wait for the placing of the document to be filed in the drawer of module 59 and the closing of the drawer of module 59. **After the drawer of module 59 is closed, the program causes the drawer of module 59 to be locked.** Now the program goes to block 220 and prints stamp 25 on the top page of document 30.

At this point the program goes to block 225 to request transport module 47 to transport document 30 from module 59 to document storage module 60. Then the program goes to decision block 226. **Block 226 obtains, if requested, the next docket number from docket data base** 48 and prints this docket number, if required, within the space provided in stamp 25, i.e., docket number 37."

Therefore, for at least the reasons above, the rejection of claim 1 should be sustained.

10.3 With respect to **claims 2-33 and 37-41,** Appellant did not provide any additional arguments. Therefore, the rejection of claims 2-33 and 37-41 should also be sustained for the same reason as given above with respect to claim 1. Note also that independent claims 12 and 33 do not recite after approval as claimed in claim 1.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Carl Colin/
Primary Examiner, Art Unit 2433
October 24, 2009

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